

REMARKS

Claims 1-7 are pending in the present application. Claims 1-5 were rejected under 35 U.S.C. §101 based on inoperativeness and lack of utility. Claim 6 was rejected under 35 U.S.C. §103 (a) as being unpatentable over Georges in view of Admitted Prior Art. Claim 7 was rejected under 35 U.S.C. §103 (a) as being unpatentable over Georges in view of Hellmuth et al., U.S. Patent No. 5,795,295, and Admitted Prior Art.

Claims 1, 6 and 7 have been amended. New claim 8 has been added.

Amendments to the claims

Independent claim 1 has further been amended to remove the recitation to the at least one abutment surface being configured to exert a force component directed substantially downward onto the support surface of the opening. Independent claims 1, 6 and 7 have been amended to recite “the ... abutment surface includes an undercut portion and contacts, above the undercut portion, the specimen slide in a region below an upper edge of the specimen slide and higher than a point of contact of the spring element with the specimen slide.” Support for this amendment may be found, for example, at Fig. 4.

It is respectfully submitted that no new matter has been added.

Rejection under 35 U.S.C. §101 to claims 1-5

Claims 1-5 were rejected under 35 U.S.C. §101 based on inoperativeness and lack of utility. The Examiner has indicated that there appears to be no physical reason the specimen slide would experience the claimed downward force. See office action at page 2, paragraph 4.

Claim 1 has now been amended, without prejudice or admission, to remove the recitation to the at least one abutment surface being configured to exert a force component directed substantially downward onto the support surface of the opening.

Withdrawal of the rejection of independent claim 1, as well as dependent claims 2-5, under 35 U.S.C. §101 is respectfully requested.

Rejection under 35 U.S.C. §103 (a) to claim 6

Claim 6 was rejected under 35 U.S.C. §103 (a) as being unpatentable over Georges in view of Admitted Prior Art.

Claim 6 of the present application, as amended, recites a first abutment surface where “a spring element is mounted on the specimen slide for pressing the specimen slide against” the first abutment surface and “wherein the first abutment surface includes an undercut portion and contacts, above the undercut portion, the specimen slide in a region below an upper edge of the specimen slide and higher than a point of contact of the spring element with the specimen slide.” It is respectfully submitted that Georges does not teach or suggest these features of claim 6. In contrast, spring 48 of Georges presses slide 12 against edge guide 46, which does not have any undercut portion. See Georges, Col. 6, lines 28-31, and Fig. 6. Moreover, the end stop 27 of Georges contacts slide 12 at an upper edge of the slide, extending beyond the upper edge. See Fig. 6. This contacting at and extension beyond the upper edge of the slide is disadvantageous, as discussed in the previous response filed 21 July 2003. With the claimed device, the slide can be removed with a reduced chance of breakage. Additionally, because the end stop of George extends beyond the upper edge of the slide, collisions with the objective of the microscope can occur, as is the case with some prior art spring clamps arranged on the upper side of the microscope stage. See present specification at page 1, lines 12-21. Georges does not provide nor suggest the above-recited features of claim 6. Neither does Admitted Prior Art teach or suggest the above features of claim 6. In contrast, in Fig. 3 (labeled “Prior Art”) of the current application, the abutment surface 3c includes no undercut portion, nor does the abutment surface contact, above the undercut portion, the specimen slide in a region below an upper edge of the specimen slide and higher than a point of contact of the spring element with the specimen slide.

Because both Georges and Admitted Prior Art are missing at least the above-recited features of claim 6, it is respectfully submitted that a combination of these would not produce the claimed invention.

Withdrawal of the rejection of claim 6 under 35 U.S.C. §103 (a) based on Georges in view of Admitted Prior Art, is respectfully requested.

Rejection under 35 U.S.C. §103 (a) to claim 7

Claim 7 was rejected under 35 U.S.C. §103 (a) as being unpatentable over Georges in view of Hellmuth et al., U.S. Patent No. 5,795,295, and Admitted Prior Art.

Claim 7 of the present application, as amended, recites a first abutment surface where “a spring element is mounted on the specimen slide for pressing the specimen slide against” the first abutment surface and “wherein the first abutment surface includes an undercut portion and contacts, above the undercut portion, the specimen slide in a region below an upper edge of the specimen slide and higher than a point of contact of the spring element with the specimen slide.” As discussed above with reference to claim 6, neither Georges nor Admitted Prior Art teach or suggest at least these features, recited in claim 7. Nor does Hellmuth et al. teach or suggest these features. Moreover, Hellmuth et al. describes a surgical microscope for use during a neurosurgical procedure (see Hellmuth et al. Abstract) not involving a specimen located on a specimen slide. As such it is respectfully submitted that Hellmuth et al. is not properly combinable with Georges, which concerns a specimen slide for use with a totally different type of biomedical specimen microscope (see Georges Abstract).

Based on at least the reasoning set forth above, withdrawal of the rejection of claim 7 under 35 U.S.C. §103 (a) based on Georges in view of Hellmuth et al. and Admitted Prior Art is respectfully requested.

New claim 8

New claim 8 has been added. Claim 8 recites the features of claim 7 without the laser cutting apparatus and collection device recitations so as to recite a microscope having the novel specimen slide holder of the present invention. Support for new claim 8 may be found, for example, at claim 7 and page 8, lines 9-23, of the present specification. It is respectfully submitted that no new matter has been added, and that claim 8 is patentable for reasons discussed above that claims 1-7 are patentable.

CONCLUSION

It is respectfully submitted that the application is now in condition for allowance.

Appl. No. 10/056,584
Resp. Dated December 8, 2003
Reply to Office Action of September 8, 2003

Atty. Docket No. 5005.1018

Respectfully submitted,

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